

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 1-3, 5-8, 10-15, 17-21, and 23-33 remain pending in the present application, claims 1, 6, 11-13, 19, and 25-27 being independent.

Prior Art Rejection

The Examiner maintains the rejection of all claims under 35 U.S.C. § 103 as allegedly being unpatentable over *Moghadam et al.* (U.S. Patent 5,799,219) in view of *Farros et al.* (U.S. Patent 5,930,810). This rejection is respectfully traversed.

1. The Invention of Independent Claim 1

Independent claim 1 is directed to a picture print ordering method which orders a print of a picture image by generating print ordering information comprising electronic data in a predetermined standard to be processed by a predetermined photo finishing system. The method of claim 1 comprises: recording high resolution picture image data obtained by reading a developed film and printing service information regarding the printing service which can be provided for the high resolution picture image data in the same portable recording medium, the printing service information being updateable information for use in generating an updateable order screen displaying available printing services from which a user

selects; displaying the printing service information and the image data recorded in the portable recording medium so as to display the order screen when the print ordering information for requesting a printing service regarding the image data recorded in the portable recording medium is generated; and generating the print ordering information by using the displayed printing service information; wherein the printing service information includes a plurality of attributes including size and kind and the name of an apparatus and/or a service provider by which the printing service information has been recorded in the portable recording medium.

As discussed for example in the Reply dated February 4, 2003, storing the "printing service information" in an updateable form on the recording medium along with the picture image data allows such information to be updated so as to allow the user to be aware of current printing capabilities of the printing service provider at the time of ordering prints. For example, as illustrated in Fig. 2, "a menu" of services associated with picture image data may be updated when there has been a change in printing service options available.

2. The Asserted Grounds of Rejection

As clarified in the "Response to Arguments" on pages 2-3 of the Office Action, and as set forth in the detailed rejection on pages 3-5 of the Office Action, the Examiner relies on the primary reference, *Moghadam*, as allegedly teaching most features recited in claim 1. On page 4 of the Office Action, the Examiner concludes that, although *Moghadam* does not specifically describe storing high resolution image data, it would have been obvious to apply the system disclosed therein to such data. Furthermore, the Examiner states on page 4 of the Office Action that:

Although, a user of the Moghadam et al. system utilizes a plurality of print service related data in order to facilitate remote image processing (column 6, lines 1-55; column 8, lines 1-26), it is not however, explicit as to whether this data is displayed to the user.

To make up for this deficiency, the Examiner relies on the secondary reference, *Farros*, and concludes on page 5 of the Office Action that:

[B]y implementing the system with visual verification and a receipt ('810. column 11, lines 22-67), a user of the Moghadam et al. system can provide evidence of service a request in the event of processing or payment errors.

At least for reasons set forth below, Applicants again respectfully submit that the stated grounds of rejection fails to

establish *prima facie* obviousness of claim 1, or any claim pending in the present application.

3. Deficiencies in the Asserted Grounds of Rejection

Moghadam is clearly directed to a system for ordering digital prints remotely, via a network. As evident for example from the "Background" section of *Moghadam*, the system disclosed therein provides network-based interfacing with a film processing service provider so that the user and other authorized persons can access digitized versions of picture images via a network and communicate print ordering instructions.

Thus, since the technique disclosed by *Moghadam* is a network-based print ordering system, the primary reference neither teaches nor suggests the principle of the claimed invention, in which the "printing service information", which is for use in generating an updateable order screen displaying available printing services from which a user selects, is updated using a portable recording medium, which also stores the high resolution image data. By referencing col. 6, ll. 1-55 of *Moghadam* in relation to the claimed "printing service information", the Examiner appears to equate this claimed information with information stored in the magnetic layer of the film used in the *Moghadam* system. Applicants note, however, that such information in *Moghadam*, as evidenced for example at col. 6,

11. 31-33, is data recorded prior to the exposed film being sent to the photo finishing processor. Therefore, such information is not updateable information used in generating an updateable order screen displaying available printing service from which a user selects as required by independent claim 1.

The Examiner's reliance on the secondary reference, *Farros*, fails to make up for this deficiency of *Moghadam*, and even if the system of *Moghadam* were modified as specified by the Examiner to include a visual display of *Farros* (which Applicants do not admit), such a system would still be a digital printing order system in which printing service information is network-based, not using a portable recording medium to update the printing service information so as to generate an updateable order screen displaying available printing services from which a user selects as required by independent claim 1.

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of prior art must be supported by some teaching, suggestion, or motivation in the applied reference or in knowledge generally available to one skilled in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Thus, "[a]ll words in a claim must be considered in judging the patentability of that

claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). It can also be said that the prior art must collectively suggest or point to the claimed invention to support a finding of obviousness. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); *In re Ehrreich*, 590 F.2d 902, 908-09, 200 USPQ 504, 510 (CCPA 1979).

At least for the above reasons, Applicants submit that the asserted grounds of rejection fails to establish *prima facie* obviousness of claim 1.

4. The Remaining Claims

Applicants respectfully submit that the remaining independent claims, as well as all dependent claims, are patentable over the applied combination of *Moghadam* and *Farros* at least based on reasoning similar to that set forth above with regard to independent claim 1.

Consequently, Applicants respectfully request reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. § 103 based on the asserted modification of *Moghadam* in view of *Farros*.

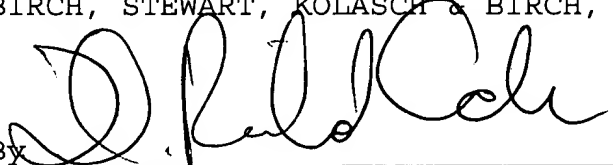
Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP



By

D. Richard Anderson, #40,439

DRA/jdm
2091-0145P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000